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10/534,617

11/02/2005

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EXAMINER

HESS, DANIEL A

ART UNIT

PAPER NUMBER

2876

MAIL DATE

DELIVERY MODE

05/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/534,617 | Applicant(s) LAZZERINI, MAURIZIO | |
| | Examiner DANIEL A. HESS | Art Unit 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8 is/are allowed.
- 6) ☒ Claim(s) 9-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2876

DETAILED ACTION

This action is responsive to applicant's communication of 1/25/2010, which has been entered into the electronic file of record.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 9-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Rancien et al.(
20040154766).

Re claims 9, 10:

Rancien teaches (see entire specification) a security thread with a microchip affixed thereto (see for instance figure 1). As is clear in paragraphs 0002 and 0005 field of Rancien's invention includes security threads for bank bills.

Chips may be affixed on a polyester film, which would be heat-sensitive. See for instance paragraph 0086.

There are options for what can be considered the support material including the varnish:

“Thereafter a heat-sealable varnish is optionally deposited thereon to reinforce adhesion”
(para 0086).

Art Unit: 2876

Also, the support material can be considered the fiber layers that are added.

Re claim 11: See paragraph 0086:

“an epoxy, a cyanoacrylate, or an isocyanate adhesive is used to fix a plurality of chips 7 on a polyester film”

Re claim 12: See paragraph 0123: There is discussed a removable silicone layer that is protective.

Re claim 13: See paragraphs 0013, 0015 and 0017 of Rancien where it is disclosed that there is an antenna for contactless data transfer.

Claims 14-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Crane (US 5,486,022).

Re claims 14, 15: Crane teaches (see column 1, lines 20+): “The threads are typically introduced during the manufacture of such security papers and generally take the form of a continuous thread or ribbon of **polyester**, regenerated cellulose, polyvinyl chloride, or other plastics film coated with a layer of metal and/or magnetic material. In particular, the thread may take the form of: a fully metallized thread, which is presently in wide use in security documents around the world; partially demetallized threads that display positive image metal characters or indicia”

Further (see column 4, lines 66+):

“The present inventive thread may include additional layers or coatings that serve to enhance the second security detection means 18 or public security feature of the present

Art Unit: 2876

invention, provided however that such coatings are not opaque and do not interfere with the signal seen by an authenticity testing device. Such coatings include fluorescent coatings made up of eosin, fluorescein, fluorspar, fuchsin, sulphate of quinine, calcium sulphide, Neodymium salicylate, Samarium gluconate, Yttrium salicylate and the like.

The security thread 10 according to the present invention may be at least partially incorporated in security papers during manufacture by techniques commonly employed in the paper-making industry. For example, the inventive thread 10 may be pressed within wet paper fibers while the fibers are unconsolidated and pliable, as taught by U.S. Pat. No. 4,534,398, resulting in the thread being totally embedded in the resulting paper. ”

As can be seen, there is a substrate, an information-bearing layer, and possibly layers on top of that (paper fibers) which can be considered the support itself.

Re claims 16 and 17: Crane's thread can go into banknotes.

Allowable Subject Matter

Claims 1-8 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The prior art fails to teach or fairly suggest

A method of manufacturing a security thread or strip introduceable in banknotes, said security thread or strip having a microchip, comprising the steps of:

Art Unit: 2876

providing a support material on a substrate to form a thread or strip; softening said support material, by heating said support material; depositing a microchip on or at least partly in the softened support material; and curing said support material, by cooling said support material.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL A. HESS whose telephone number is (571)272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2876

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Daniel A Hess/

Primary Examiner, Art Unit 2876